

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application in view of the amendments and the remarks to follow. Claims 1-36 and 40-49 were previously canceled and new claims 62-65 are added. Claims 37-39 and 50-65 are pending in this application. Entry of the amendments and reconsideration of the application are requested in view of the amendments and the remarks to follow.

New claims 62-65 are supported at least by text appearing at page 4, line 2 through page 46, line 15 of the application. No new matter is added by new claims 62 et seq. New claims 62 et seq. distinguish over the art of record and are allowable.

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35 U.S.C. § 102

Claims 37-39 and 55-61 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,587,129 B1 to Lavendel et al. (hereinafter "Lavendel"). Applicant respectfully disagrees and requests reconsideration.

Anticipation is a legal term of art. Applicant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the reference must include every element of the claim within the four corners of the reference (see MPEP §2121); (ii) the elements must be set forth as they are recited in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be modified (see MPEP §706.02, stating that "No question of obviousness is present" in conjunction with anticipation); and (iv) the reference must enable the invention as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions must be simultaneously satisfied.

Applicant notes the requirements of MPEP §2131, which states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM." This MPEP section further states that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of

terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

Lavendel is directed (see, e.g., Title) to a "user interface for image acquisition devices". Lavendel describes (see Abstract): "A user interface for image acquisition devices that provides common control of common features of different image acquisition devices while retaining the flexibility needed to provide tailored control that take advantage of unique features of each different image acquisition device. The user interface includes a control area for displaying a property sheet. The property sheet has a plurality of property pages, each of which has an interface for image acquisition device control and each of which has a tab describing the control provided by that property page. At least one property page has an interface for core image acquisition device control, and at least one property page has an interface for device-dependent image acquisition device control. The user interface also provides a property sheet with a property page that attractively provides plural interfaces for control in that property page. The property page includes a control region for providing control and a button region having multiple buttons. An appearance of the control region is changed in response to user manipulation of the multiple buttons, with each different appearance providing a different interface for the control."

In contrast, claim 37 recites "An application program interface for an image acquisition system, the application program interface being embodied on a computer-readable medium and having methods for performing the following functions: creating a device object for an imaging device; displaying a user interface to enable a user to choose the device object; displaying a user interface to

enable the user to capture an image using the imaging device; and querying the imaging device for properties", while claim 55 recites "An application program interface for an image acquisition system, the application program interface being embodied on a computer-readable medium and having processes for performing the following functions: creating a device object for an imaging device; displaying a user interface to enable a user to choose the device object; displaying a user interface to enable the user to capture an image using the imaging device; and querying the imaging device for properties of the imaging device", which recitations are not taught or disclosed by Lavendel.

The Office Action states (p. 5) that "Lavendel teaches querying the imaging device for properties (col. 3, lines 8-67; col. 4, lines 1-40)." Applicant respectfully disagrees for reasons that are explained below in more detail.

These passages variously describe:

a common interface for common features of different image acquisition devices, while retaining flexibility needed to tailor the interface for unique features of different imaging devices (col. 3, line 8 et seq.);

a user interface provided by a TWAIN data source (line 26 et seq.);

a user interface that includes a property sheet with a plurality of pages (line 32 et seq.), whereby the user may select a property page (line 44 et seq.);

a user interface that controls an image acquisition device (line 52 et seq.);

a user interface with multiple buttons arranged based on user familiarity with or complexity of the different interfaces resulting from user manipulation of the multiple buttons (col. 4, line 12 et seq.);

an aspect whereby the appearance of a property page is changed so as to provide plural different interfaces (line 27 et seq.).

These passages are silent with respect to any "application program interface" having "methods for performing" any function of "querying the imaging device for properties", as recited in claim 37. These passages are also silent with respect to any "application program interface for an image acquisition system" having processes for "querying the imaging device for properties of the imaging device", as recited in claim 55.

They merely provide different user modalities for accessing and displaying information for image and image device manipulation already contained within the computing system or in a TWAIN data source. The TWAIN data source is explicitly described (col. 5, line 56 et seq.) as a fixed disc 6 or CD-ROM associated with the computer system 1, and not as a part of an imaging device.

Operation of the TWAIN data modules is described in more detail with reference to Fig. 2 et seq. In particular, Fig. 3 and col. 6, line 49 et seq. describe user-selectable options on a menu 32 which "includes a list of available TWAIN data sources" (lines 52 and 53) such as "IMAGE ACQUISITION DEVICE 52", "IMAGE ACQUISITION DEVICE A", "IMAGE ACQUISITION DEVICE B" etc. (Fig. 3, menu 32).

In other words, Lavendel teaches user selection from a predetermined list of devices for which property information is obtained from a canned or preprogrammed data source external to any imaging device, and does not teach or disclose "querying the imaging device for properties", as recited in claim 37.

Indeed, Applicant has explicitly stated (specification, page 1, line 18) that "TWAIN lacks robustness and interoperability" and that (line 20 et seq.) "Accordingly, a task set before the inventor was to create an image acquisition system that was *based on an open architecture model* and could be integrated with existing applications and operating systems to provide a convenient environment for the user."

The Office Action also states (page 3) that Lavendel teaches "querying the imaging device for properties (col. 9, lines 7-22; col. 10, lines 41-59)." These passages are reproduced below.

Col. 9, lines 7-22 of Lavendel states that:

In FIG. 7, user interface 64 has main window 65, which includes preview area 67, tool bar 68, control area 69, status bar 70, and logo box 71.

Preview area 67 includes preview button 73 and scan button 74. When preview-button 73 is selected, a selected image acquisition device delivers preview image 76 at the resolution of display 2. Because this resolution is relatively low, typically about 75 dpi, this preview scan is extremely fast. Preview image 76 is displayed in preview area 67. User interface 64 then can be manipulated so as to adjust preview image 76 and to adjust the selected image acquisition device, as described below. Preview image 76 immediately reflects these adjustments. Then, when scan button 74 is selected, the image acquisition device delivers an image according to the adjustments.

This passage is void of any mention of querying the imaging device for properties. The passage at col. 10, lines 41-59 is reproduced below:

FIG. 8 is a view illustrating "Main" property page 94, which provides an interface for main core control. "Main" property page 94 is device-independent; it is included in property sheet 92 regardless of the kind of image acquisition device connected to computer system 1. For example, "Main" property page 94 is included in property sheet 92 regardless of whether the image acquisition device is a scanner, a digital camera, or a film adapter unit. Accordingly, the interface for control displayed in "Main"

property page 94 corresponds to core features common to different image acquisition devices.

In the preferred embodiment, the main control corresponds to core TWAIN control. The main control includes the most essential control for controlling a TWAIN-compliant image acquisition device. Thus, "Main" property page 94 includes scan mode area 100, scan resolution area 102, and scan selection area 104. Any user manipulation made in these areas is immediately reflected by preview image 76.

Lavendel also states (col. 10, line 21 et seq.) that:

Control area 69 includes property sheet 92 with plural property pages 94 through 98. Each property page includes a tab describing control provided by the property page. Thus, "Main" property page 94 provides main control, "Tone" property page 95 provides tone control, and "Preferences" property page 96 provides preferences control. Because a model CS600 scanner and an FAU are attached to computer system 1 and the necessary software is loaded on hard drive 6, property sheet 92 includes "CS600" property page 97 and "FAU" property page 98. "CS600" property page 97 provides control of the CS600 model scanner, and "FAU" property page 98 provides control of the film adaptor unit.

The Office Action notes (pages 2 and 3) that Lavendel describes use of a TWAIN data source, and describes such as a dynamic link library providing device driven functionality. Such would logically be stored on a computer, and not on an imaging device. Querying a computer that is not part of an imaging device for device information is not equivalent to Applicant's claimed subject matter.

In fact, Lavendel explicitly states (col. 6, line 49 et seq.) that:

FIG. 3 shows user interface 30 of a client image processing application. Upon selection of "Acquire" button 31, menu 32 is displayed. As shown, menu 32 includes a list of available TWAIN data sources. In accordance with the TWAIN protocol, Acquire button 31 provides a link to a TWAIN data source manager, which provides, in turn, information required to create menu 32.

FIG. 4 is a block diagram illustrating a TWAIN-compliant system utilizing the presently-described TWAIN data source architecture. The system includes client image processing application 40 for processing images received from image acquisition devices, data

files, or the like. As stated above, client image processing application 40 communicates with TWAIN source manager 41 upon user selection of Acquire button 31. Although indicated as separate elements in FIG. 4, **TWAIN source manager 41 is often bundled together with client image processing application 40.**

TWAIN source manager 41 is responsible for locating TWAIN data sources, calling TWAIN data sources, and for managing communication with TWAIN data sources. As described above, a TWAIN data source is a dynamic link library (DLL) which provides both device driver functionality and a TWAIN user interface to a TWAIN-compliant image processing application. In the present case, the subject data source provides a core TWAIN user interface and also provides means for supporting a dynamically-loaded device-dependent user interface.

TWAIN access module 44 identifies the subject TWAIN data source to TWAIN source manager 41. Moreover, TWAIN access module 44 presents a software entry point to TWAIN source manager 41, as required by the TWAIN specification. TWAIN source manager 41 uses the entry point to pass TWAIN triplets to the subject TWAIN data source.

Lavendel thus describes a "canned" data source permitting a user to select a device driver from a library of such drivers that is stored on a computer, and does not teach or disclose querying an image device for properties. As such, Lavendel fails to even comprehend the problems addressed by the claimed subject matter and cannot possibly provide the solutions encompassed thereby.

Lavendel fails to provide the elements of claims 37 and 55, and thus cannot provide them as they are set forth in the claim. Because Lavendel is concerned with different subject matter, Lavendel requires modification impermissible in conjunction with anticipation and cannot possibly enable the subject matter of the claims.

The anticipation rejection of claims 37-39 and 55-61 thus fails the tests noted above. As a result, the anticipation rejection of claims 37-39 and 55-61 is

clearly prima facie defective and should be withdrawn, and claims 37-39 and 55-61 should be allowed.

35 U.S.C. § 103

Claims 50-54 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lavendel in view of the IBM Technical Disclosure Bulletin entitled "Host System and Attached Non-Programmable Terminal with Open Parallel Port" (hereinafter "IBM").

The Office Action states (p. 6) that "Lavendel teaches a first and a second user interface portion having a graphics window including a user interface area having a menu and toolbar area and a context space separate from the menu and toolbar area (figs. 3, 7); the second user interface portion including a preview scan space within the context space (figs. 7-11e; col. 2, lines 63-67; col. 3, lines 1-24, 33-46)."

Lavendel is directed (see, e.g., Title) to a "user interface for image acquisition devices". Lavendel describes (see Abstract): "A user interface for image acquisition devices that provides common control of common features of different image acquisition devices while retaining the flexibility needed to provide tailored control that take advantage of unique features of each different image acquisition device. The user interface includes a control area for displaying a property sheet. The property sheet has a plurality of property pages, each of which has an interface for image acquisition device control and each of which has a tab describing the control provided by that property page. At least one property page has an interface for core image acquisition device control, and at least one property page has an interface for device-dependent image acquisition device control. The user interface also provides a property sheet with a property page that attractively provides plural interfaces for control in that property page. The

property page includes a control region for providing control and a button region having multiple buttons. An appearance of the control region is changed in response to user manipulation of the multiple buttons, with each different appearance providing a different interface for the control."

Applicant finds no such teaching in Lavendel. The Office Action does not identify where such teaching or disclosure might be found. Clarification of the rejection is requested.

The Office Action further states (pages 6 and 7) that "Lavendel does not teach that the preview scan space is configured to progressively display an image within the preview scan space to visually convey that the imaging device is scanning the image. However, IBM discloses an image scanning application program interface (API) that can be added on a host system; the host application enabled to have a menu where the user initiates image scanning. IBM teaches a Preview Mode, wherein data from the scanner could be displayed in an Online Setup Mode Screen so that the user can scan view the scanned image as the compressed data is passed to the work station controllers (WSC), (page 475 and 478)."

IBM does not cure the deficiencies of Lavendel. IBM is silent regarding mode of display. IBM is silent regarding any progressive display of anything, and also is silent regarding any visual conveyance of scanning activity. There is simply nothing in these passages that teaches, discloses, suggests or motivates "preview scan space is configured to progressively display an image within the preview scan space to visually convey that the imaging device is scanning the image", as recited in claim 50.

IBM indicates (page 478) that "The NPT could support multiple display sessions. A user could initiate an image scan in one session (which could take a while for a multi-page document on a scanner with a sheet feeder). Then the user could switch to a different session to do other host work while the image scanning is in progress."

Why would IBM teach that the user could switch to other tasks while scanning was in progress if IBM provided any indication of scan progress to the user? IBM provides no teaching of why or how any "user interface progressively displaying the image within the preview scan space to visually convey that the scanner is scanning the image" might be effectuated in the context of scanning a multi-page document with a sheet feeder or of how such might be employed or even why one might employ such a feature.

Why would IBM provide such teaching if IBM even contemplated the subject matter of claim 50? There is no discussion identified in IBM by the Office Actions of any affirmative indication of scanning progress.

Applicant notes the requirements of MPEP §2143, entitled "Basic Requirements of a Prima Facie Case of Obviousness" (see also MPEP §706.02(j), entitled "Contents of a 35 U.S.C. 103 Rejection."). MPEP §2143 states that "To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Inasmuch as the references fail to teach or disclose the elements recited in the claims, the references cannot provide motivation to modify their teachings to arrive at the

invention as claimed, and the Examiner has identified no such teaching or disclosure in the reference. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the reference fails to provide all of the features recited in Applicant's claims, the third prong of the test is not met. As a result, there cannot be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the references fail to teach or disclose the elements recited in the claims.


Accordingly, the unpatentability rejection of claims 50-54 is prima facie defective and should be withdrawn, and claims 50-54 should be allowed.

Conclusion

Claims 37-39 and 50-65 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

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By: 
Frederick M. Fliegel
Reg. No. 36,138
(509) 324-9256 x239